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**OFFICE OF PETITIONS**

In re Patent No. 7,799,535  
Issued: September 21, 2010  
Application No. 09/207,649  
Filed: December 8, 1998  
Attorney Docket No. **17481-0004001**

DECISION ON REQUEST FOR  
RECONSIDERATION OF  
PATENT TERM ADJUSTMENT

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) filed November 22, 2010, requesting that the patent term adjustment determination under 35 U.S.C. § 154(b) be changed from 117 days to 159 days.

The request is **DISMISSED**.

Patentees are given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer**, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On September 21, 2010, the above-identified application matured into U.S. Patent No. 7,799,535 with a revised patent term adjustment of 117 days. On November 22, 2010, patentees timely submitted this application for patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 159 days.

Patentee disputes the reduction of 42 days for applicant delay and argues that Patentee complied with the Examiner's request and submitted the requested courtesy copy of the originally filed oath or declaration, missing from the Office's file (though it had been submitted in a timely manner during prosecution of the application). Therefore, Patentee respectfully submits that the post-allowance submission should not be considered a failure to engage in reasonable efforts to conclude prosecution of the application as outlined in 37 C.F.R. § 1.704(c)(10).

Patentee's argument has been considered but is not found to be persuasive.

A review of the file reveals that 42 days were deducted for applicant delay for the filing of supplemental papers on August 11, 2010, after allowance of an Application for Patent Term Adjustment. The reduction in question, after the mailing of the Notice of Allowance was an OATH OR DECLARATION.

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;
- or
- (ii) Four months;

The reduction has been considered a proper a basis for reduction of patent term adjustment pursuant to § 1.704(c)(10).

As stated in MPEP 2732:

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process.

Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application.

See *Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a “Notice of Allowance” is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner’s reasons for allowance or a request to correct an error or omission in the “Notice of Allowance” or “Notice of Allowability;” and (7) letters related to government interests (e.g., those between NASA and the Office).

Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a

refund; (2) a status letter; (3) amendments under 37 CFR 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations.

The record does not support a conclusion that the Oath or Declaration had been previously submitted and thus the filing of the Oath or Declaration was required to complete the record. A review of the file does reveal that papers were filed on March 24, 1999, in response to the Notice to File Missing Parts mailed January 25, 1999 and the transmittal indicates that the filing of the Oath or Declaration was intended, however, the evidence presented does not prove that the Oath or Declaration was actually filed. Prima Facie evidence of the March 24, 1999 could however exist in the date stamped post card receipt noted on page two of the transmittal included with the filing on that date. Without such evidence, the reduction pursuant to 37 CFR 1.704(c)(10) is proper and the patent term adjustment indicated in the patent is properly reflected.

The Office acknowledges the submission of the required fee of \$200.00 set forth in 37 CFR 1.18(e).

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball  
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Office of Petitions